

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:  Mark A. FELKEY et al.	Confirmation No.: 7571
Application No.: 10/051,282	Group Art Unit: 3627
Filed: January 22, 2002	Examiner: Thein, M.
Customer No.: 30671	
Attorney Docket: WMA01001	
Client Docket: 09710_1116	

For: METHOD AND SYSTEM FOR PROCURING TELECOMMUNICATIONS SERVICES  
ON-LINE

**REPLY BRIEF**

Honorable Commissioner for Patents  
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed June 17, 2008.

**I. STATUS OF THE CLAIMS**

Claims 1-15, 17, 21-23, 27-30, 32-36, 40, and 41 are pending and are on appeal. Claims 16, 18-20, 24-26, and 31 have previously been canceled, and claims 37-39 have been previously withdrawn. No claim is allowed. Claims 1-4, 7-15, 17, 21-23, 35, and 36 remain rejected under 35 U.S.C. §103 as obvious based on *Liljestrand et al.* (US 6,853,714) in view of *Bednarek* (US 6,965,868). Claims 5 and 6 remain rejected under 35 U.S.C. §103 as obvious based on *Liljestrand et al.* (US 6,853,714) in view of *Bednarek* (US 6,965,868) and further in view of

*Guidice et al.* (US 6,463,420). Claims 27-30 and 32-34 remain rejected under 35 U.S.C. §103 as obvious based on *Liljestrand et al.* (US 6,853,714) in view of *Bednarek* (US 6,965,868) and further in view of *Sridhar et al.* (US 6,098,108). Claims 40 and 41 remain rejected under 35 U.S.C. §103 as obvious based on *Liljestrand et al.* (US 6,853,714) in view of *Bansal* (US 6,788,949).

Claims 1-15, 17, 21-23, 40, and 41 now stand rejected under 35 U.S.C. §101 in a New Grounds of Rejection presented in the Examiner's Answer of June 17, 2008.

## II. GROUNDS OF REJECTION TO BE REVIEWED

Whether claims 1-4, 7-15, 17, 21-23, 35, and 36 are obvious under 35 U.S.C. §103 based on *Liljestrand et al.* (US 6,853,714) in view of *Bednarek* (US 6,965,868)?

Whether Claims 5 and 6 are obvious under 35 U.S.C. §103 based on *Liljestrand et al.* (US 6,853,714) in view of *Bednarek* (US 6,965,868) and further in view of *Guidice et al.* (US 6,463,420)?

Whether claims 27-30 and 32-34 are obvious under 35 U.S.C. §103 based on *Liljestrand et al.* (US 6,853,714) in view of *Bednarek* (US 6,965,868) and further in view of *Sridhar et al.* (US 6,098,108)?

Whether claims 40 and 41 are obvious under 35 U.S.C. §103 based on *Liljestrand et al.* (US 6,853,714) in view of *Bansal* (US 6,788,949)?

Whether claims 1-15, 17, 21-23, 40, and 41 are directed to nonstatutory subject matter under 35 U.S.C. §101?

### III. ARGUMENT

Appellants maintain and incorporate the positions presented in the Appeal Brief filed March 22, 2008, but present further refutation of certain assertions presented in the Examiner's Answer and present arguments against the new ground of rejection of claims 1-15, 17, 21-23, 40, and 41 under 35 U.S.C. §101.

With regard to the rejections under 35 U.S.C. §103, Appellants continue to maintain that the rejections are improper because the primary reference to *Liljestrand et al.*, as explained in the principal Appeal Brief, fails to disclose a **procurement inquiry by a customer application**, as required by independent claims 1 and 35, an **inquiry from a customer application**, as required by independent claims 12 and 36, or an **inquiry**, as required by independent claim 21, and the other applied references do not provide for the deficiencies of *Liljestrand et al.*.

The Examiner now stresses the disclosure, at col. 3, lines 54-59, of *Liljestrand et al.*, of the integration of the enhanced local exchange with "a variety of **revenue-generating** enhanced services" (Answer-page 20), along with the disclosure at col. 8, lines 40-47 regarding manipulation of subscriber profile information via a voice-activated interface or via a web-activated interface which also "provides access to subscriber billing information and account status," as well as "automatically creating new accounts for customers that want to sign up for services." Ostensibly, these various functions, being related to billing and new accounts, are being relied on as evidence of "a procurement inquiry by a customer application," "an inquiry from a customer application," and "any procurement data generation of that procurement data, procurement inquiry or transmission of any procurement data to a customer application." (See Answer-page 22). To the extent that the Examiner is contending that *Liljestrand et al.* is

suggesting that there is a fee for providing telecommunication services (“revenue-generating enhanced services,” providing “billing information and account status,” etc.), Appellants do not necessary deny that *Liljestrand et al.* provides telecommunication services for a fee. However, the mere disclosure of a fee-for-services telecommunication system, *per se*, is not a disclosure or a suggestion of the method and apparatus for “procuring telecommunications offerings” wherein “a procurement inquiry from a customer application...specifying a selected telecommunications offering from a plurality of offerings” is received and “procurement data” is generated “in response to the procurement inquiry.” There is no disclosure or suggestion in the applied references of a customer application specifying a selected telecommunications offering **“from a plurality of offerings.”** *Liljestrand et al.* does not suggest any menu of offerings from which a customer application makes a selection. While *Liljestrand et al.* is directed to providing telecommunications services to customers, it is, in no way, shape, or form, directed to a method or system for procuring those telecommunication services by offering certain services, or offerings, to customer applications that then select from a plurality of such offerings by making a “procurement inquiry” and, in response thereto, “generating procurement data in response to the procurement inquiry.”

The Examiner contends that the claims have been “given their broadest reasonable interpretation consistent with the supporting description” (Answer-page 22) but Appellants respectfully disagree. It is **not** reasonable to conclude that the “procurement” limitations, including “a procurement inquiry from a customer application...specifying a selected telecommunications offering from a plurality of offerings” that is received and “procurement data” that is generated “in response to the procurement inquiry” is broad enough to read on the

mere disclosure of any system providing telecommunications services and charging for such services.

The “virtual administrator” of *Liljestrand et al.*, disclosed at col. 4, lines 15-23, is associated with a voice-activated interface within an enhanced services platform. This “virtual administrator” assists the subscriber “in requesting/performing all desired services via the voice-activated interface.” However, while platform 100 of *Liljestrand et al.* “offers three types of service” (Col. 4, line 46) and the virtual administrator assists the subscriber “in requesting/performing all desired services,” there is no disclosure of “a procurement inquiry from a customer application...specifying a selected telecommunications offering from a plurality of offerings” being received and “procurement data” being generated “in response to the procurement inquiry.” Further, it is not clear that in assisting with “requesting/performing” desired services, the “virtual administrator” is reacting to “a procurement inquiry from a customer application...specifying a selected telecommunications offering from a plurality of offerings” by generating “procurement data” “in response to the procurement inquiry.” In the example given by *Liljestrand et al.*, the subscriber (note that this is not a “customer application,” as claimed), after being prompted for a voice command by the “virtual administrator,” says, “Call Mike” and, in response thereto, the “virtual administrator” automatically connects the subscriber to Mike. However, this example is not suggestive of “a **procurement inquiry** from a customer application...specifying a selected telecommunications offering from a plurality of offerings” that is received and “**procurement data**” that is generated “in response to the procurement inquiry.”

Moreover, to whatever extent the “virtual administrator” in *Liljestrand et al.* may be considered a “network consultant,” there is no provision in *Liljestrand et al.* of “an option for

accessing a network consultant **via instant messaging**,” as required, for example, by claim 1. While the Examiner relies on *Bednarek* for this feature, the use of instant messaging would not be feasible in *Liljestrand et al.* because instant messaging is directed to a live person who can then respond to the instant message, whereas the “virtual administrator” in *Liljestrand et al.* is an automated system, not capable of communicating via instant messaging. Therefore, the skilled artisan would not have sought to modify *Liljestrand et al.* with the instant messaging teaching of *Bednarek*.

Regarding the specifics of claims 5 and 6, these claims recite “transmitting the ordering data including at least one of shopping cart data, or order entry data” and “transmitting the post-sale data including at least one of order tracking data, or order status data,” respectively, *Liljestrand et al.* and *Bednarek*, of course, fail to teach or suggest these features because these references are not related to the specific process of ordering and purchasing telecommunications services and, so, do not disclose “shopping cart data,” “order entry data,” “order tracking data,” or “order status data.” *Guidice et al.*, relied on by the Examiner for this claim feature, is directed to tracking the delivery status over a computer network. It is not concerned with “shopping cart data,” “order entry data,” “order tracking data,” or “order status data” as they relate to procuring telecommunications services. Accordingly, the skilled artisan would have had no reason, save for Appellants’ own disclosure, to modify *Liljestrand et al.* and *Bednarek*, to include online tracking and order status delivery information, as taught by *Guidice et al.*, in providing for enhanced telecommunication services, as taught by *Liljestrand et al.*

With regard to the rejection of claims 27-30 and 32-34, Appellants rely on their arguments set forth at pages 13-14 of the principal Appeal Brief but merely respond to the Examiner’s comment, at page 29 of the Answer, that the “claims were given their broadest reasonable

interpretation..." In fact, the broad interpretation the Examiner has given to the claims is **not** reasonable because, for the reasons *supra*, the applied references do not disclose or suggest a procurement inquiry, generation of procurement data, or a transmission of the procurement data. *Sridhar et al.* does not provide for these deficiencies.

With regard to claims 40 and 41, Appellants again stress that not only does *Bansal* not provide for the deficiencies of *Liljestrand et al.* with regard to "ordering" a telecommunications services product, but even if it did, there would have been no reason to combine these two references. The Examiner contends that *Bansal* teaches instant messaging and on-line shared white-boarding and that the motivation to combine *Bansal* with *Liljestrand et al.* is "to provide a chat session that allows to enter and send messages simultaneously col. 1, lines 22-24" (Answer-page 33). The Examiner's rationale for making this combination is without basis. Merely because *Bansal* sets up a chat session in no way makes such a chat session an obvious modification to the system of *Liljestrand et al.* In fact, *Liljestrand et al.* would have no use for such a chat session because there is no communication between a user or user application and a real person in *Liljestrand et al.* The "virtual administrator" of *Liljestrand et al.* merely provides voice prompts to a user employing a voice-activated, or web-activated, interface but the "virtual administrator" cannot be, and would not be, a participant in a chat room session. Therefore, it makes no sense to attempt to combine an instant messaging and/or white-board teaching with the teachings of *Liljestrand et al.* as the "consultant" in *Liljestrand et al.* is a non-person "virtual administrator" to which one would never provide options including "**instant messaging and on-line shared white-boarding**, wherein the option is displayed via a customer application to a user."

**REJECTION OF CLAIMS 1-15, 17, 21-23, 40, and 41 UNDER 35 U.S.C. §101**

The rejection of claims 1-15, 17, 21-23, 40, and 41 under 35 U.S.C. §101 is flawed and the Honorable Board is respectfully requested to reverse this rejection.

The Examiner contends that a process, within the meaning of 35 U.S.C. §101 must be tied to another statutory class or transform underlying subject matter into a different state or thing. While the Examiner cites four United States Supreme Court cases from 1876 extending through 1981, the Examiner does not indicate which of these cases stands for the proposition that any process within 35 U.S.C. §101 “must be tied to another statutory class” and Appellants are aware of no case law from the U.S. Supreme Court or Federal Circuit asserting such. The Examiner appears to be relying on a recent Board decision in *In re Langemyr et al.*, Appeal No. 2008-1495, of May 28, 2008.

A clear reading of 35 U.S.C. §101 indicates that “process” stands as a separate statutory category of invention on a par with “machine, manufacture, or composition of matter” or “improvement thereof” and does not depend on any other category for its legality, although the process may involve another statutory class of invention, as in a process for operating a machine, or a process for making a manufacture, etc. In fact, the definition of “process” is set forth in 35 U.S.C. §100(b) as “process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.” The “process” or “method” set forth in claims 1-15, 17, 21-23, 40, and 41 is clearly a “process” within the meaning of 35 U.S.C. §101.

Further, contrary to the Examiner’s assertion, the physical transformation of subject matter is not the dispositive requirement of Section 101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir.), cert. denied, 528 U.S. 946 (1999). In any event, there is a transformation described in the claims at issue. Taking claim 1 as exemplary, the

claim sets forth a method for procuring telecommunications offerings. The method transforms a procurement inquiry from a customer application, via intermediate steps, into procurement data that is transmitted to the customer application in response to the procurement inquiry. There is nothing nonstatutory about such a method, or process, as it does not fall within an exception to statutory subject matter, e.g., the instant claims do not recite a merely abstract idea or a law of nature or a pure mathematical algorithm. The MPEP itself recites, “The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter -- [provided the subject matter falls into at least one category of statutory subject matter] but rather on the essential characteristics of the subject matter, in particular, **its practical utility**” MPEP 2106(IV)(B). Each of the rejected claims is directed to a **computer-implemented method** or a **computer-readable media** or a method for **electronic provisioning**. Accordingly, since the methods are tied specifically to being performed on a computer, electronically, or as part of a physical media, it is clear that the claims are not directed to any abstract ideas but, rather, have some physical manifestation to them. Thus, it is clear that a machine, such as a programmed computer or other electronic machinery is required, either expressly or implicitly, to perform the recited methods.

In *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1375, 47 USPQ2d 1596, 1602 (Fed. Cir. 1998), the court indicated that the focus of a statutory subject matter analysis should be “on the essential characteristics of the subject matter, in particular, its **practical utility**.” These principles were reinforced in *AT&T Corp.* These cases required a “practical application” of the claimed method, i.e., “a useful, concrete, and tangible result,” in order to satisfy the test for statutory subject matter within the meaning of 35 U.S.C. §101. Under

such a test, the instant claims clearly pass muster under 35 U.S.C. §101. It is clearly a “useful, concrete, and tangible result” to procure telecommunications offerings by a computer-implemented method whereby a procurement inquiry is made by a customer application and procurement data is transmitted to the customer application in response to that inquiry. This is very “useful” to a subscriber of telecommunication services to be able to order and procure such services on-line. It is concrete and tangible when the customer application has the procurement data transmitted so the services/offering are now available for use by the customer/subscriber.

With regard to the Board decision in *Langemyr et al.*, the claims therein recited a method of modeling whereby the end result of the claims was, in reality, a mathematical algorithm. Accordingly, in that decision, the process was not the type of process envisioned by 35 U.S.C. §101. One could argue that the claims in *Langemyr et al.*, being directed to a mathematical algorithm, or a model of a mathematical algorithm, fell into an exception to 35 U.S.C. §101, viz., a mathematical algorithm. Because the end result of those claims was a model for a mathematical algorithm, one might argue that there was no “practical result,” or no “useful, concrete, and tangible result.” However, the instant claims are distinguishable thereover because they are directed to a very practical result, having a very “useful, concrete, and tangible result,” because they result in delivery to a customer application of telecommunication services in response to an inquiry regarding such services or offerings.

The instant claims meet every definition of “process” within the meaning of 35 U.S.C. §101 and they are in conformance with all applicable recent case law, including the recent Board decision in *Langemyr et al.*, regarding 35 U.S.C. §101. Accordingly, the Honorable Board is respectfully requested to reverse the Examiner’s decision rejecting claims 1-15, 17, 21-23, 40, and 41 under 35 U.S.C. §101.

**IV. CONCLUSION AND PRAYER FOR RELIEF**

Claims 1-15, 17, 21-23, 40, and 41 are clearly directed to statutory subject matter within the meaning of 35 U.S.C. §101. Moreover, the subject matter of claims 1-15, 17, 21-23, 27-30, 32-36, 40, and 41 is not obvious over the applied references. Appellants, therefore, request the Honorable Board to reverse each of the Examiner's rejections.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

July 25, 2008  
Date

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